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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,180	04/01/1998	BRIAN J. REISTAD	06543035001	2217
24573	7590	11/13/2003		EXAMINER
BELL, BOYD & LLOYD, LLC				BACKER, FIRMIN
PO BOX 1135				
CHICAGO, IL 60690-1135			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/054,180	REISTAD ET AL
	Examiner Firmin Backer	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 October 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-36 and 39-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-36 and 39-63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

Response to Request for Reconsideration

This is in response to a request for reconsideration file October 8th, 2003. Claims 12-36 and 39-63 are being reconsidered in this action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12-36, 39-63 rejected under 35 U.S.C. 102(e) as being anticipated by Candelore (U.S. Patent No. 6,057,872).

3. As per claim 12, Candelore teaches an electronic commerce system (*transaction communication system,, fig 1*) comprising a client computer (*receiving end, 130*) and a server computer (*transmitting end, 110*), (*see fig 1*) the client computer and the server computer being interconnected (*channel, 120*) by a public packet switched communications network (*see fig 1, column 5 lines 6-25*), the client computer being programmed to transmit to the server computer an order acceptance request comprising a plurality of terms or conditions of a proposed offer for a purchase, the order acceptance request comprising a discrete message that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic

security codes within each of the modular elements, at least one of the modular elements individually protected by a cryptographic security code being a digital coupon (*see fig 1, 2, column 5 lines 6-25, 7 lines 19-9 line 65*), the server computer being programmed to process the order acceptance request based on pre-programmed criteria, including authentication of the cryptographic security codes embedded within each of the modular elements and examination of the modular elements of the discrete message individually protected by the cryptographic security codes, and, based on the processing of the order acceptance request, to transmit to the client computer an order acceptance response based on the pre-programmed criteria, the order acceptance response comprising a discrete message transmitted during a negotiation phase of a transaction that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements, wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code (*keys*), from another computer (*see fig 1, 2, column 5 lines 6-25, 7 lines 19-9 line 65*).

4. As per claim 13-36, 39-63, they disclose the same inventive concept as claim 12.

Therefore, they are rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed October 8th, 2003 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fail to teach an inventive concept wherein a negotiation process between a client and a server in which the client terminal sends a purchase order request to the server and the server send a response. Examiner respectfully disagrees with applicant's characterization with the prior art. Candelore teaches a user interface 226 enables a viewer to select program services for viewing on a television (TV) 180. If a user is authorized to receive the selected service by subscription, individual purchase (e.g., *pay per view*), or according to a digital coupon credit, the secure processor 220 will actuate the switch 218 to couple the decrypted output 216 from decryption processor 212 to the TV 180 via user interface 226. The digital coupon information may provide a discount when the user terminals order one or more PPV programs through the PPV order processing function 115. As an example, if a terminal orders five PPV programs within the current billing cycle, the digital coupon credit may allow the terminal to order a sixth PPV program at no charge. Or, for terminals that order PPV programs infrequently, the digital coupon credit may allow the terminal to order a first PPV program at half-price.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John W. Hayes
JOHN W. HAYES
PRIMARY EXAMINER

Firmin Backer
Firmin Backer
Examiner
Art Unit 3621

November 11, 2003